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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,879	04/17/2001	Jed Arkin	62962(52398)	5203
21874 7590 05/16/2007 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205			EXAMINER WINDER, PATRICE L	
			ART UNIT 2145	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/836,879	ARKIN ET AL.	
	Examiner	Art Unit	
	Patrice Winder	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-190 is/are pending in the application.
- 4a) Of the above claim(s) 1-39, 67-105, 181-190 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-66 and 106-180 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8-13-01; 2-13-02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse in the reply filed on June 7, 2006 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the Examiner. Applicant's argument is not persuasive because there are two undue burdens: 1) searching another invention especially considering the prior art and 2) considering the prior art associated with the other invention.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 40-66, 106-180 are rejected under 35 U.S.C. 102(e) as being anticipated by Hale et al., USPN 6,732,180 B1 (hereafter referred to Hale).

4. Regarding claim 40, Hale taught system for producing intellectual property (IP) item modified copies (abstract), the system comprising:

a network interface coupled to a network (column 8, lines 29-35); and

a processor coupled to said network interface (column 8, lines 29-35); wherein said processor produces at least one modified copy from at least one item (column 8, lines 10-17), said at least one modified copy is to be made available to said network via said network interface (column 6, lines 14-19; column 8, lines 49-55).

5. Regarding dependent claim 41, Hale taught the type of said at least one item is selected from the list consisting of: Intellectual Property (IP) item; and Infringing item (column 3, lines 1-9).

6. Regarding dependent claim 42, Hale taught the type of content of said at least one item, is selected from the list consisting of: audio; video; software; computer game; data; and e-book (column 2, lines 63-67).

7. Regarding dependent claim 43, said processor further comprises a translator, said translator produces a translated name for said at least one item, according to at least one item characteristic of said at least one item, respectively.

8. Regarding dependent claim 44, Hale taught said processor makes said modified copy available to said network by placing a respective modified copy pointer in a directory, said directory being coupled to said network (column 4, lines 53-55; column 8, lines 29-38).

9. Regarding dependent claim 45, Hale taught the type of said directory is selected from the list consisting of: centralized; distributed; and search engine (column 8, lines 29-38; 61-65).

10. Regarding dependent claim 46, Hale taught the type of the connection between said network interface and said network is selected from the list consisting of: wireless link; and wired (column 10, lines 42-55).

11. Regarding dependent claim 47, Hale taught the type of said network is selected from the list consisting of: publicly accessed network; and network application (column 4, lines 60-63).

12. Regarding dependent claim 48, Hale taught at least one modified copy characteristic of said at least one modified copy, is identical with at least one item characteristic of said at least one item (column 8, lines 18-28).

13. Regarding dependent claim 49, Hale taught said at least one modified copy characteristic is selected from the list consisting of: title; file size; category; date of production; producer; and performer (column 8, lines 18-28).

14. Regarding dependent claim 50, Hale taught at least one modified copy characteristic of said at least one modified copy, is similar to at least one item characteristic of said at least one item (column 8, lines 18-28).

15. Regarding dependent claim 51, Hale taught said at least one modified copy characteristic is selected from the list consisting of: title; file size; category; date of production; producer; and performer (column 8, lines 18-28).

16. Regarding dependent claim 52, Hale taught said at least one modified copy comprises at least two out-of-sequence segments of said at least one item separated by at least one supplementary material (column 8, lines 11-18).

17. Regarding dependent claim 53, Hale taught said at least one modified copy comprises at least two out-of-sequence segments of said at least one item followed by at least one supplementary material (column 8, lines 11-18).

18. Regarding dependent claim 54, Hale taught a first portion of said at least one modified copy comprises at least a portion of the beginning segment of said at least one item, and a second portion of said at least one modified copy comprises a recurring supplementary material (column 8, lines 11-18).

19. Regarding dependent claim 55, Hale taught the size of said at least substantially equal to the size of said at least (column 8, lines 22-28).

20. Regarding dependent claim 56, Hale taught said processor produces said at least one modified copy, when said at least one item is available to said network (column 11, lines 1-6).

21. Regarding dependent claim 57, Hale taught said processor produces said at least one modified copy, when said at least one item is not available to said network (column 10, lines 43-55).

22. Regarding dependent claim 58, Hale taught said processor produces said at least one modified copy according to predicted production parameters (column 11, lines 6-13).

23. Regarding dependent claim 59, Hale taught said processor produces a plurality of modified copy sets, each of said modified copy sets comprising said at least one modified copy, wherein at least one modified copy characteristic of said at least one modified copy in one of said modified copy sets, is different than said at least one

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modified copy characteristic in another one of said modified copy sets (column 7, lines 37-60).

24. Regarding dependent claim 60, Hale taught said network interface periodically changes at least one attribute respective thereof (column 10, lines 35-41).

25. Regarding dependent claim 61, Hale taught said at least one attribute is selected from the list consisting of: network interface card identification; logical user name; network service provider; and network protocol address (column 9, lines 1-6).

26. Regarding dependent claim 62, Hale taught said network interface uploads said at least one modified copy to at least one share infringing user, at a high quality of service, during the uploading of the beginning portion of said at least one modified copy, and at a low quality of service during the uploading of the remainder of said at least one modified copy (column 8, lines 11-18).

27. Regarding dependent claim 63, Hale taught said network interface uploads said at least one modified copy to at least one share infringing user, and wherein said network interface alternates the quality of service during said uploading between a high value and a low value (column 8, lines 11-18).

28. Regarding dependent claim 64, Hale taught said network interface has at least one identity (column 9, lines 1-6).

29. Regarding dependent claim 65, Hale taught said at least one identity is selected from the list consisting of: media access control address; network protocol address; user name; and uniform resource locator (column 9, lines 1-6).

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30. Regarding dependent claim 66, Hale taught said processor attaches a digital signature of a share-infringing user to said at least one modified copy, by employing a public key of said share-infringing user (column 1, lines 38-50).

31. The language of claims 106-180 is substantially the same as previously rejected claims 40-66. Therefore, claims 106-180 are rejected on the same rationale as previously rejected claims 40-66, above.

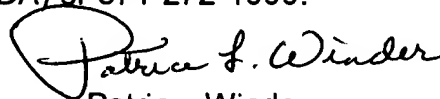
Conclusion

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patrice Winder
Primary Examiner
Art Unit 2145

September 5, 2006